

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: 14283US02

PATENT

In the Application of:

Jeyhan Karaoguz, et al.

Serial No.: 10/667,829

Filed: September 22, 2003

For: MEDIA PROCESSING SYSTEM
SUPPORTING USER CAPTURED
MEDIA DISPLAY SEQUENCING
WHEN IN IDLE STATE

Examiner: Schnurr, John R.

Group Art Unit: 2421

Confirmation No.: 1006

Electronically Filed On July 27, 2010

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Paper responds to the Final Office Action mailed April 27, 2010.

The Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

Respectfully submitted,

Date: July 27, 2010

By: /Joseph M. Butscher/
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REMARKS

The present application includes pending claims 1-12, 14-26, 28-32, and 34-38, all of which have been rejected. Claims 1-6, 9-12, 14-17, 21-26, 28-32, 34, 37, and 38 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 6,601,237 (“Ten Kate”) in view of U.S. 2002/0054752 (“Wood”) and U.S. 2002/0166127 (“Hamano”). Claims 7, 8, 18-20, 35, and 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Ten Kate in view of Wood, Hamano and U.S. 2004/0261096 (“Matz”). As explained below, however, the Office Action fails to establish a *prima facie* case of unpatentability with respect to the pending claims.

The Applicants demonstrate that the Office Action does not establish that the proposed combination renders the pending claims unpatentable. *See* February 9, 2010 Amendment at pages 9-13.

Claim 1 recites, in part, “storage **at the first location** for storing all idle state media and all user scheduled media; a user interface for identifying particular media as **one of the idle state media or the user scheduled media [stored at the first location]**...”

Claim 10 recites, in part, “selecting particular **user stored** media as one of idle state media or user scheduled media based upon input from a user at a first location, wherein the user scheduled media includes selected stored media arranged according to time;...”

Claim 21 recites, in part, “selecting the media **stored at the first location** as idle state media or user scheduled media based upon input from a user, wherein the user scheduled media is scheduled based on broadcasting time;...”

Claim 29 recites, in part, “wherein **all of the idle state media and the user scheduled media is stored in the storage at the first location**, wherein all of the idle state media and the user scheduled media are scheduled based on time.”

The Office Action states the following:

Ten Kate clearly teaches a method of operating a system supporting user captured media display sequencing, the method comprising:

selecting particular user stored media as one of idle state media or user scheduled media based upon input from a user at a first location; **(A user selects programs to create a virtual channel, column 4 line 64 to column 5 line 3. The user selects default media to fill the gaps in the virtual channel schedule, column 5 line 66 to column 6 line 8)**

See April 27, 2010 Office Action at page 5 (emphasis in original). The Office Action relies on similar reasoning for independent claims 1 and 21.

Notably, the Office Action relies on Ten Kate as allegedly disclosing these limitations. See *id.* However, the Applicants respectfully submit that **the Office Action's reliance on Ten Kate as disclosing these limitations is misplaced**, as explained below. Accordingly, a *prima facie* case of obviousness with respect to the pending claims has not been established.

In Ten Kate, the “virtual channel means are adapted to control the tuner to tune to a channel currently broadcasting a selected program. When a user selects the virtual channel, the apparatus takes care of automatically switching between the genuine channels broadcasting the programs viewed on the virtual channel.” See Ten Kate at Abstract.

Thus, Ten Kate discloses a system in which a user identifies particular programs for a virtual channel. However, **these programs are shown on genuine channels, but are not stored entirely at the user's location**. Moreover, **the user does not schedule the times of these programs**. Instead, the times are dictated by the “genuine channels.” The “apparatus takes care of automatically switching between the genuine channels broadcasting the programs viewed on the virtual channel.” See *id.* **Thus, in Ten Kate, the user does not schedule any stored media according to a time schedule.**

Ten Kate also discloses that “scheduling means are further adapted to record the second program, and reschedule it for the virtual channel to fill a gap before or after the programs scheduled for the virtual channel.” See *id.* at column 2, lines 36-40. In Ten Kate, the times for the virtual channel are essentially dictated by those set by the genuine channels. Portions of a second program may merely be recorded to fill in the gaps between times of programs broadcast by the genuine channels.

The Applicants respectfully submit that, **contrary to the express reasoning in the Office Action** (See April 27, 2010 Office Action at page 5, reproduced above), Ten Kate does not describe, teach, or suggest “storage **at the first location for storing all idle state media and all user scheduled media**; a user interface for identifying particular media as **one of the idle state media or the user scheduled media [stored at the first location]**,” as recited in claim 1, “selecting particular **user stored** media as one of idle state media or user scheduled media based upon input from a user at a first location, wherein the user scheduled media includes selected

stored media arranged according to time,” as recited in claim 10, “selecting the media **stored at the first location** as idle state media or user scheduled media based upon input from a user, wherein the user scheduled media is scheduled based on broadcasting time,” as recited in claim 21, or “wherein **all of the idle state media and the user scheduled media is stored in the storage at the first location**, wherein all of the idle state media and the user scheduled media are scheduled based on time,” as recited in claim 29.

Accordingly, the Applicants respectfully submit that the Office Action’s reasoning is misplaced, and therefore, a *prima facie* case of unpatentability has not been established. The Office Action has not demonstrated that any of the cited references describes, teaches, or suggests all of the limitations noted above.¹ Thus, for at least these reasons, the Applicants respectfully request reconsideration of the claim rejections.

Additionally, claim 1 recites, in part, “**displaying, from the storage at the first location, of idle state media when no user scheduled media is available on the television display at the first location and the at least one display device at the second location.**” Claims 10, 21, and 29 recite similar limitations. Thus, the claims are clear that the **idle state media stored at the first location is displayed at first and second locations**.

The Office Action acknowledges that Ten Kate combined with Wood does not describe, teach or suggest idle state media stored at a first location being displayed at the first location and the second location. *See* April 27, 2010 Office Action at page 4. In an attempt to overcome this deficiency, the Office Action relies on Hamano. *See id.* at page 4.

Hamano, however, only discloses advertisements displayed on a remote display. *See* Hamano at [0037]. In particular, Hamano discloses a set top box that “transmits the advertising information that has been targeted to the user to the remote display terminal via wireless transmission.” *See id.* at [0044]. Similar to Ten Kate and Wood, however, Hamano does not describe, teach or suggest displaying information stored at a first location on a display at the first location **and** a display at the second location. Instead, similar to the Ten Kate and Wood, Hamano only discloses display at one location. **None of Ten Kate, Wood or Hamano** describes, teaches or suggests “the set top box circuitry at the first location causing the

¹ While the Office Action cites Wood at Figure 10 and [0059]-[0061] as disclosing the relevant limitations (*see* 4/27/10 Office Action at page 2), there is nothing in these cited portions of Wood that overcomes the noted deficiencies of Ten Kate).

displaying, from the storage at the first location, of idle state media when no user scheduled media is available on the television display at the first location **and the at least one display device at the second location,**” as recited in claim 1. Because none of these references describes, teaches, or suggests this limitation, the combination of all three cannot, by definition, describe, teach, or suggest it.²

Thus, for at least these reasons, the Office Action fails to establish a *prima facie* case of unpatentability with respect to the independent claims and the claims that depend therefrom.

The Applicants respectfully request that the outstanding rejections be reconsidered and withdrawn. If the Examiner has any questions or the Applicants can be of any assistance, the Examiner is invited to contact the undersigned attorney.

The Commissioner is authorized to charge any necessary fees, **including the \$540 fee for the Notice of Appeal**, or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

Date: July 27, 2010

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² The Applicants are aware that “one cannot show nonobviousness by attacking the references individually,” but if none of the references discloses a limitation, aggregating those references together cannot possibly make the limitation, which is not found in any of the references, somehow appear. For example, if references A, B, and C are silent with respect to element X, then A+B+C cannot somehow yield element X.